

### **REMARKS**

Claim 33 has been amended. No new matter has been added.

Claims 15 to 33 are now pending in the present application.

Applicants respectfully request reconsideration of the present application in view of this response.

#### **35 U.S.C. § 112, second paragraph**

Claim 33 was rejected under 35 U.S.C. § 112, second paragraph, for improper antecedent basis. Claim 33 has been amended above to delete the reference to “second data portion.” No new matter has been added. Applicants thank the Examiner for noting this informality. Accordingly, Applicants respectfully submit that claim 33 as amended is now allowable; and withdrawal of the rejection of claim 33 is respectfully requested.

#### **35 U.S.C. § 102(b) – Kahn reference**

Claims 15 to 19, 21, 22, 24 to 31 and 33 were rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 5,978,649 to Kahn (“Kahn reference”).

As discussed in Applicants’ earlier response, the Kahn reference refers to a method and apparatus for dynamic conditional channel authorization in a broadcast system where each receiver unit is associated with an authorization information identifying subsets of the communication signal and is authorized to process. Abstract, lines 1-5. The method for controlling access to the communication signal includes receiving a conditional instruction, the conditional instruction specifying a modification of the authorization information conditioned upon whether the receiver unit belongs to a receiver unit category, and executing the conditional instruction to modify the authorization information conditioned upon whether the receiver unit belongs to the receiver unit category. Abstract, lines 5-13.

In contrast, claim 15 is directed to a method for routing data in a pay-TV terminal, the data including receiving rights for a mobile data carrier, having transmitting the data from a transmitter via a transmission medium to the pay-TV terminal; buffering the data using the pay-TV terminal; establishing communication between the mobile data carrier and the pay-TV terminal; and then routing the receiving rights to the mobile data carrier and storing the receiving rights in the mobile data carrier, wherein the data includes at least second receiving rights for a second mobile data carrier. The Kahn reference does not identically recite all of the features of claim 15, including buffering the data using the pay-TV terminal; establishing

communication between the mobile data carrier and the pay-TV terminal; and then routing the receiving rights to the mobile data carrier and storing the receiving rights in the mobile data carrier, wherein the data includes at least second receiving rights for a second mobile data carrier. Instead, the Kahn reference refers to a broadcast system in which apparently descriptive information is stored in the form of bitmap flags which can identify subsets of the communication signal that a particular IRD is authorized to process. Col. 6, lines 7-11. The Kahn reference continues and describes a memory unit in the form of a set of bitmap flags in the bitmap, each bitmap flag being associated with a particular subset of the communication signal or service. Col. 6. Each flag apparently represents whether the receiver unit is authorized to process a respective channel group. Col. 2.

To reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Not only must each of the claim limitations be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter, as discussed herein. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)). In particular, it is respectfully submitted that the Kahn reference relied upon would not enable a person having ordinary skill in the art to practice the subject matter of the claims as presented.

Claim 17 recites features analogous to those of claim 15, including buffering the data using the pay-TV terminal; establishing communication between the mobile data carrier and the pay-TV terminal; and then routing the receiving rights to the mobile data carrier and storing the receiving rights in the mobile data carrier, wherein the data includes at least second receiving rights for a second mobile data carrier; and is therefore allowable over the Kahn reference for essentially the same reasons as for claim 15.

Claim 24 is directed to a device for decoding pay-TV programs, including the features of a control and evaluation electronics; a communication apparatus for communicating with a first mobile data carrier via an interface; and a memory for use as a list so as to buffer data transmitted from a transmitter to the device via a transmission medium using the control and evaluation electronics, at least a first portion of the buffered data being routed immediately or at a later time to the first mobile data carrier. In contrast, the Kahn reference refers to a reception apparatus in a broadcast system having a communication signal transmitted to a plurality of receiver units wherein each receiver unit has authorization information identifying

subsets of the communication signal the receiver unit is authorized to process, the reception apparatus having a receiver that receives a conditional instruction, the conditional instruction specifying a modification of the authorization information conditioned upon whether the receiver unit belongs to a receiver unit category. Col. 2, lines 51-61. The Kahn reference further describes that the reception apparatus also has a mechanism for executing the conditional instruction to modify the authorization information conditioned upon whether the receiver unit belongs to the receiver unit category. Col. 2, lines 61-65. The Kahn reference does not identically describe (as it must for anticipation) the features of a communication apparatus for communicating with a first mobile data carrier via an interface; and a memory for use as a list so as to buffer data transmitted from a transmitter to the device via a transmission medium using the control and evaluation electronics, at least a first portion of the buffered data being routed immediately or at a later time to the first mobile data carrier. Accordingly, Applicants respectfully submit that claim 24 is allowable over the Kahn reference; and, withdrawal of the rejection of claim 24 over the Kahn reference is respectfully requested.

The Office Action relies extensively on the inherency doctrine. In this regard, it is respectfully submitted that to rely on inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). *Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.* Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

Claim 30 recites features analogous to those of claim 24, including a memory for use as a list so as to buffer data transmitted from a transmitter to the device via a transmission medium using the control and evaluation electronics, at least a first portion of the buffered data being routed immediately or at a later time to the first mobile data carrier. Claim 30 also recites that the communication device is for communicating with the first mobile data carrier and with a second mobile data carrier and wherein the control and evaluation electronics includes a control module for performing an allocation respectively between the first portion and a second portion of the buffered data and the first and second mobile data carriers.

Accordingly, Applicants respectfully submit that claim 30 is allowable over the Kahn reference for at least the same reasons as claim 24; and, withdrawal of the rejection of claim 30 over the Kahn reference is respectfully requested.

Claim 31 recites features analogous to those of claim 24, including a memory for use as a list so as to buffer data transmitted from a transmitter to the device via a transmission medium using the control and evaluation electronics, at least a first portion of the buffered data being routed immediately or at a later time to the first mobile data carrier. Claim 31 also recites that the communication device is for communicating with the first mobile data carrier and with a second mobile data carrier and wherein the control and evaluation electronics includes an evaluation module for determining which of the first and second mobile data carriers is in communication with the pay-TV terminal so as to enable a respective routing of the first portion of the buffered data and a second portion of the buffered data. Accordingly, Applicants respectfully submit that claim 31 is allowable over the Kahn reference for at least the same reasons as claim 24; and, withdrawal of the rejection of claim 31 over the Kahn reference is respectfully requested.

Claim 33 recites features analogous to those of claim 24, including a memory for use as a list so as to buffer data transmitted from a transmitter to the device via a transmission medium using the control and evaluation electronics, at least a first portion of the buffered data being routed immediately or at a later time to the first mobile data carrier. Accordingly, Applicants respectfully submit that claim 33 is allowable over the Kahn reference for at least the same reasons as claim 24; and, withdrawal of the rejection of claim 33 over the Kahn reference is respectfully requested.

Since the remaining claims depend from one of the foregoing claims 15, 17, 24, 30, 31 and 33, the remaining claims are allowable over the Kahn reference for at least the same reasons as claim 15, 17, 24, 30, 31 or 33. Withdrawal of the rejection of claims 15 to 33 under 35 U.S.C. § 102(b) is respectfully requested.

### **35 U.S.C. § 103(a) – Kahn reference**

Claims 20, 23 and 32 were rejected under 35 U.S.C. § 103(a) over the Kahn reference.

Since claims 20 and 23 depend from claim 17, those claims are allowable over the Kahn reference for at least the same reasons as for claim 17.

Claim 32 recites features analogous to those in claim 33 including the feature(s) of a memory for use as a list so as to buffer data transmitted from a transmitter to the device via a

transmission medium using the control and evaluation electronics, at least a first portion of the buffered data being routed immediately or at a later time to the first mobile data carrier, and is therefore allowable over the Kahn reference for essentially the same reasons.

Accordingly, Applicants respectfully submit that claims 20, 23 and 32 are allowable over the Kahn reference; and withdrawal of the rejection under 35 U.S.C. § 103(a) is respectfully requested.

In summary, it is respectfully submitted that all of claims 15 to 33 of the present application are allowable for the foregoing reasons.

#### CONCLUSION

In view of all of the above, it is believed that the rejection of claims 15 to 33 under 35 U.S.C. §§ 112, 102(b) or 103(a) have been overcome. Accordingly, it is respectfully submitted that all claims 15 to 33 are allowable. It is therefore respectfully requested that the rejections be reconsidered and withdrawn, and that the present application issue as early as possible.

If it would further allowance of the present application, the Examiner is invited to contact the undersigned at the contact information given below.

Dated: Apr. 28, 2004

Respectfully submitted,

By: Richard L. Mayer  
Richard L. Mayer (Reg. No. 22,490)

By AS  
Reg. No. 47084

**CUSTOMER NO. 26646**

KENYON & KENYON  
One Broadway  
New York, New York 10004  
(212) 425-7200